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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,009	05/03/2005	Ruth Chiquet-Ehrismann	FM-05-US	1199
50446 7590 05/06/2009 HOXIE & ASSOCIATES LLC 75 MAIN STREET, SUITE 301 MILLBURN, NJ 07041				
EXAMINER				
GUSLOW, ANNE				
ART UNIT		PAPER NUMBER		
1643				
MAIL DATE		DELIVERY MODE		
05/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,009

Applicant(s)

CHIUQUET-EHRISMANN ET AL.

Examiner

ANNE M. GUSSOW

Art Unit

1643

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14-52, 58-60 and 65-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 14-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-60 and 65-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/30/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Morris et al. Table 1.

DETAILED ACTION

1. Claims 58 and 66 have been amended.

Claims 11-13, 53-57, 61-64, and 69-72 have been cancelled.

Claims 1-10 and 14-52 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 27, 2007.

2. Claims 58-60 and 65-68 are under examination.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on December 30, 2008 was filed after the mailing date of the first action on the merits on February 27, 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner and an initialed copy of the IDS is included with the mailing of this office action.

Rejections Withdrawn

4. The rejection of claims 66-68 under 35 U.S.C. 112, second paragraph as being indefinite is withdrawn in view of applicant's amendment to the claims.

Rejections Maintained

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The rejection of claims 58-60 and 65-68 under 35 U.S.C. 102(e) as being anticipated by Morris, et al. (US PG PUB 2002/0182586, filed March 1, 2002) is maintained.

Applicant's arguments filed December 30, 2008 have been carefully considered but they are deemed not to be persuasive. The response states that "A reference must have disclosure publicly available as of its publication date in order to be anticipatory under 35 U.S.C. §102(e). See MPEP 2136.03, pg. 2100-93. The invention has to be described in "the application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for the patent. "In this case, the published Morris application, U.S. 2002/0182586, nowhere discloses SEQ ID NO: 2022, as of its publication date. The application merely discloses a Table 1 but does not provide SEQ ID NO: 2022. Furthermore, a search on the USPTO's publication site for issued and published sequences; at <http://seqdata.uspto.gov>, revealed that no such sequence was publicly available as of its publication date. Copies of the searches are

herein attached, for reference. Furthermore, a search of the Morris application on Public Pair revealed that a preliminary amendment, which includes a table listing SEQ ID NO: 2022, was received in the United States Patent Office, on July 14, 2003, well after the filing date of this application." See response page 10.

In response to this argument, the disclosure of SEQ ID No. 2022 was included in Table 1 as filed March 1, 2002. The PG PUB discloses the sequences in Table 1 on page 22 paragraph 222. The accompanying CD-ROM was available in the patent office as of March 1, 2002, a text copy of the file is attached to this office action. The sequence listing filed on July 14, 2003 merely gave each sequence a unique sequence identifier (SEQ ID No.) it did not change the content of the previously filed disclosure. Thus, the sequence of SEQ ID No. 2022 was available as of the filing date of Morris, et al. March 1, 2002.

Therefore, it is the Examiner's position that Morris, et al. have produced antibodies that are directed to the same antigen that the claimed antibodies bind and in turn, antibodies that bind to amino acids 791-1054 of SEQ ID No. 4. One of ordinary skill in the art would reasonably conclude that Morris' antibody also possesses the same structural and functional properties as those of the antibodies claimed and, therefore, it appears that Morris has produced antibodies that are identical to the claimed antibody. Since the Patent and Trademark Office does not have the facilities for examining and comparing the claimed antibody with the antibody of Morris, the burden of proof is upon the Applicants to show a distinction between the structural and functional characteristics of the claimed antibody and the antibody of the prior art. See In re Best, 562 F.2d 1252,

195 U.S.P.Q. 430 (CCPA 197) and Ex parte Gray, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

Therefore after a fresh consideration of the claims and the evidence provided the rejection is maintained.

Conclusion

7. No claims are allowed.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNE M. GUSSOW whose telephone number is

(571)272-6047. The examiner can normally be reached on Monday - Friday 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anne M. Gussow
May 4, 2009

/David J Blanchard/
Primary Examiner, Art Unit 1643